

**IN THE UNITED STATES DISTRICT COURT
FOR THE MIDDLE DISTRICT OF NORTH CAROLINA**

BASF AGRO B.V., ARNHEM (NL),
WÄDENSWIL BRANCH,
BAYER S.A.S., and MERIAL LIMITED,

Plaintiffs,

v.

CHEMINOVA, INC.,

Defendant.

Civil Action No. 10-cv-274

JOINT PRE-HEARING STATEMENT

Joint Pre-Hearing Statement
BASF Agro B.V. et al. v. Cheminova, Inc., C.A. No. 10-cv-274-WO-WWD

Parties' Proposed Constructions: The Manufacturing Patents

U.S. Patent No. 6,620,943		
Terms for Construction	Plaintiffs' Proposed Construction and Support	Defendant's Proposed Construction and Support
<p>“compound”</p> <p>'943 patent claims 14 and 22</p>	<p>No construction necessary. Plain and ordinary meaning: A substance whose molecules consist of unlike atoms and whose constituents cannot be separated by physical means.</p> <p>Intrinsic evidence support:</p> <p><i>See infra</i> under “corrosion inhibiting compound.”</p> <p>Extrinsic evidence support:¹</p> <p>Compound: [CHEM] A substance whose molecules consist of unlike atoms and whose constituents cannot be separated by physical means. <i>McGraw-Hill Dictionary of Scientific and Technical Terms</i> (5th ed. 1994) [PA 228]; <i>McGraw-Hill Dictionary of Chemistry</i> (1997) [D.I.</p>	<p>One or more of the same molecule that each have the same molecular structure with elements in fixed proportion</p> <p>'943 Patent (e.g. Abstract, claim 1);</p> <p>Dkt. No. 68, Pltf. Opening Brief (e.g. p. 6);</p> <p>Dkt. No. 70-1, First Decl. of Mark Lipton (e.g. ¶¶ 8-9, 13, 29);</p> <p>Dkt. No. 78 Pltf. Answer Brief, (e.g. p. 7);</p> <p>Dkt. No. 78-2, Decl. of Jeffery Winkler (e.g. ¶¶ 32, 35-36);</p> <p>Dkt. No. 85, Supp. Decl. of Mark Lipton (e.g. ¶¶ 3-27);</p>

¹ Plaintiffs' position remains that the claim terms can be properly construed using only intrinsic evidence. However, extrinsic evidence supporting Plaintiffs' constructions is recited herein to assist the Court.

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	<p>69-23, PA 236].</p> <p>Compound: [CHEM] A substance made up of two or more elements that cannot be separated by physical means. <i>The Cassell Dictionary of Science</i> (1997) [D.I. 69-26, PA 240].</p> <p>Compound: A substance consisting of atoms or ions of two or more different elements in definite proportions joined by chemical bonds into a molecule. The elements cannot be separated physically. <i>The American Heritage Science Dictionary</i> (2005) [D.I. 69-32, PA 257].</p> <p>Declaration of Jeffrey Winkler in Response to Defendant Cheminova, Inc.'s Opening Claim Construction Brief [D.I. 78-5] ¶¶ 21-42.</p> <p>Decl. of Jeffrey Winkler, Ph.D. in Response to Defendant Cheminova, Inc.'s Brief in Support of its Motion for Summary Judgment [D.I. 132-10] ¶¶ 9-55.</p> <p>Lipton Tr. [D.I. 132-4] e.g. 30:5-32:5, 33:15-36:19, 37:14-21, 39:19-41:6, 44:11-20, 47:3-9, 53:9-54:16, 55:16-56:10, 63:15-67:8, 80:22-81:8.</p> <p>Lipton Tr. [D.I. 132-5] e.g. 184:3-189:3.</p>	<p>Dkt. No. 101, Motion for Summary Judgment Decl. of Mark Lipton (e.g. ¶¶ 19-43) and exhibits;</p> <p>Def. Supp. Brief, Exh. A, Dep. Tr. of Jeffrey Winkler (e.g. 44:7-45:12, 49:3-7, 52:2-59:25, 72:25-78:4, 80:18-24, 111:19-112:11, 113:16-114:6, 212:13-221:6);</p> <p>Def. Opening Brief, Exh. 7, Dep. Trans. of Keith Holmes (e.g. 211:5-12).</p>

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	Nordlying Tr. [D.I. 132-6] e.g. 223:20-228:21. Winckelmann Tr. [D.I. 132-7] e.g. 36:6-19.	
<p>“in the presence of”</p> <p>‘943 patent claims 14 and 22</p>	<p>No construction necessary. Plain and ordinary meaning: The corrosion inhibiting compound is present during the claimed oxidation process</p> <p>Intrinsic evidence support:</p> <p>“A process for the preparation of a compound of formula (I)... comprising oxidizing a compound of formula (II)... with trifluoroperacetic acid in the presence of a corrosion inhibiting compound such as boric acid.” (‘943 patent, Abstract [D.I. 69-19, PA 178]).</p> <p>“A process (A) for the preparation of a compound of formula (I)... which process comprises oxidising a compound of formula (II)... with trifluoroperacetic acid in the presence of a corrosion inhibiting compound.” (‘943 patent as originally filed, August 15, 2002, Claim 1 [D.I. 69-21, PA 197]).</p> <p>“A process according to claim 1 or 2 in which the corrosion inhibiting compound is boric acid.”</p>	<p>Available in the reaction medium or takes part in the reaction</p> <p>'943 Patent (e.g. 1:57-59, 1:66-2:8, 2:17-19, 2:44-46, 2:53-54, 4:44);</p> <p>Dkt. No. 68, Pltf. Opening Brief, (e.g. p. 7);</p> <p>Dkt. No. 70-1 First Decl. of Mark Lipton (e.g. ¶¶ 18-28);</p> <p>Docket No. 85, Supp. Decl. of Mark Lipton (e.g. ¶¶ 24-27);</p> <p>Dkt. No. 101, Motion for Summary Judgment Decl. of Mark Lipton (e.g. ¶¶ 61- 64);</p> <p>Dkt. No. 105, Krumholz Decl. Exhibit 5;</p> <p>Def. Supp. Brief, Exh. A, Dep. Trans. of Jeffrey Winkler (e.g. 150:9-21, 151:23-155:15, 169:29-170:10);</p> <p>Def. Supp. Brief, Exh. B, Winkler Summary Judgment Declaration (e.g. ¶¶ 92-93).</p>

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	<p>('943 patent as originally filed, August 15, 2002, Claim 3 [D.I. 69-21, PA 198]).</p> <p>"A process according to claim 1, 2 or 3 in which the amount of corrosion inhibiting compound used is about 0.08-0.2 molar equivalents." ('943 patent as originally filed, August 15, 2002, Claim 4 [D.I. 69-21, PA 198]).</p> <p>"A process for the preparation of a compound of formula (I)... which process comprises... (c) oxidising a compound of formula (II) with trifluoroperacetic acid in the presence of a corrosion inhibiting compound." ('943 patent as originally filed, August 15, 2002, Claim 26 [D.I. 69-21, PA 201]).</p> <p>"... oxidizing the resultant compound of formula (II) with trifluoroperacetic acid in the presence of a corrosion inhibiting compound to afford a compound having the formula (I)." ('848 patent as originally filed, July 3, 2003, Claim 32 [D.I. 69-22, PA 211-13]).</p> <p>"... oxidizing the resultant compound having formula (II) with trifluoroperacetic acid in the presence of a corrosion inhibiting compound."</p>	

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	<p>('848 patent as originally filed, July 3, 2003, Claim 63 [D.I. 69-22, PA 221-23]).</p> <p>Extrinsic evidence support:</p> <p>Declaration of Jeffrey Winkler in Response to Defendant Cheminova, Inc.'s Opening Claim Construction Brief [D.I. 78-5] ¶¶ 43-57.</p> <p>Declaration of Jeffrey Winkler, Ph.D. in Response to Defendant Cheminova, Inc.'s Brief in Support of its Motion for Summary Judgment [D.I. 132-10] ¶¶ 85-94.</p> <p>Lipton Tr. [D.I. 132-4] e.g. 91:16-92:25.</p> <p>Lipton Tr. [D.I. 132-5] e.g. 93:1-94:11; 106:13-107:20; 109:4-116:19; 117:14-118:9.</p>	
<p>"corrosion inhibiting compound"</p> <p>'943 patent claims 14 and 22</p>	<p>A compound that inhibits (prevents, stops or decreases) corrosion resulting from, or that might be expected to result from, the claimed oxidation process</p> <p>Intrinsic evidence support:</p> <p>"A number of oxidants . . . have been employed. . .</p>	<p>A hydrogen fluoride trapping agent</p> <p>'943 Patent (e.g. Abstract, claims 1 & 7, 1:46-60, 4:63-67, 11:33-52);</p> <p>Dkt. No. 10, Exh. C, Sukopp Dec., (e.g. ¶ 11);</p> <p>Dkt. No. 70-1, First Decl. of Mark Lipton (e.g. ¶¶ 31-39);</p>

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	<p>. It has now been found that a mixture of trifluoroacetic acid and hydrogen peroxide (trifluoroperacetic acid) gives excellent results in terms of both selectivity and yield.” ('943 patent, col. 1, ll. 36-48 [D.I. 69-19, PA 179]).</p> <p>“However a problem of using the trifluoroacetic acid and hydrogen peroxide mixture on large scales is that it leads to corrosion of the glass linings of industrial reaction vessels, which is rapid (typically 300 um/year) even at ambient temperatures, whilst at 80° C. the speed of corrosion increases to about 1430 um/year. This corrosion occurs as a result of the formation of hydrogen fluoride, and therefore prohibits the use of this reagent mixture in such vessels.” ('943 patent, col. 1, ll. 49-56 [D.I. 69-19, PA 179]).</p> <p>“It has now been found that the addition of a corrosion inhibiting compound such as boric acid to the reaction mixture inhibits the corrosion process and reduces the speed of corrosion to a level that is typically less than 5 um/year. ('943 patent, col. 1, ll. 57-60 [D.I. 69-19, PA 179]).</p> <p>“It is a further object of the present invention to provide a process for preparing 5-amino-1-aryl-3-</p>	<p>Dkt. No. 78 Pltf. Answer Brief, (e.g. p. 7);</p> <p>Dkt. No. 78-2, Decl. of Jeffery Winkler (e.g. ¶¶ 15, 19);</p> <p>Docket No. 85, Supp. Decl. of Mark Lipton (e.g. ¶¶ 31-32);</p> <p>Dkt. No. 101, Motion for Summary Judgment Decl. of Mark Lipton (e.g. ¶¶ 8-10, 15, 46-49, 53-56);</p> <p>Dkt. No. 105, Krumholz Decl. Exhibits 5, 6;</p> <p>Def. Supp. Brief, Exh. A, Dep. Tr. of Jeffrey Winkler (e.g. 141:16-147:16, 179:20-184:3, 184:9-193:17, 199:2-15, 203:4-20, 211:3-226:17);</p>

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	<p>cyano-4-trifluoromethylsulphonylpyrazole pesticides which is simple and safe to perform, and which results in minimal vessel corrosion.” ('943 patent, col. 3, ll. 23-27 [D.I. 69-19, PA 180]).</p> <p>“The corrosion inhibiting compound is generally boric acid or an alkali metal borate such as sodium borate; or any hydrogen fluoride trapping agent such as silica (silicon dioxide), optionally in the form of silica oil. Preferably the corrosion inhibiting compound is boric acid.” ('943 patent, col. 4, ll. 63-67 [D.I. 69-19, PA 180]).</p> <p>“The amount of corrosion inhibiting compound used is generally 0.08-0.22 molar equivalents, and preferably about 0.08-0.1 molar equivalents.” ('943 patent, col. 5, ll. 1-3 [D.I. 69-19, PA 181]).</p> <p>“A process for the preparation of a compound of formula (I)... comprising oxidizing a compound of formula (II)... with trifluoroperacetic acid in the presence of a corrosion inhibiting compound such as boric acid.” ('943 patent, Abstract [D.I. 69-19, PA 178]).</p> <p>“A process (A) for the preparation of a compound of formula (I)... which process comprises oxidising a compound of formula (II)... with</p>	

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	<p>trifluoroacetic acid in the presence of a corrosion inhibiting compound.” ('943 patent as originally filed, August 15, 2002, Claim 1 [D.I. 69-21, PA 197]).</p> <p>“A process according to claim 1 or 2 in which the corrosion inhibiting compound is boric acid.” ('943 patent as originally filed, August 15, 2002, Claim 3 [D.I. 69-21, PA 198]).</p> <p>“A process according to claim 1, 2 or 3 in which the amount of corrosion inhibiting compound used is about 0.08-0.2 molar equivalents.” ('943 patent as originally filed, August 15, 2002, Claim 4 [D.I. 69-21, PA 198]).</p> <p>“A process for the preparation of a compound of formula (I)... which process comprises... (c) oxidising a compound of formula (II) with trifluoroacetic acid in the presence of a corrosion inhibiting compound.” ('943 patent as originally filed, August 15, 2002, Claim 26 [D.I. 69-21, PA 201]).</p> <p>“... oxidizing the resultant compound of formula (II) with trifluoroacetic acid in the presence of a corrosion inhibiting compound to afford a compound having the formula (I).” ('848 patent as originally filed, July 3, 2003, Claim 32 [D.I. 69-22,</p>	

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	<p>PA 211-13]).</p> <p>"... oxidizing the resultant compound having formula (II) with trifluoroacetic acid in the presence of a corrosion inhibiting compound." ('848 patent as originally filed, July 3, 2003, Claim 63 [D.I. 69-22, PA 221-23]).</p> <p>"... wherein the corrosion inhibiting compound is boric acid or an alkali metal borate." ('943 patent, Claims 3-4 [D.I. 69-21, PA 184]).</p> <p>"... wherein the corrosion inhibiting compound is boric acid." ('943 patent, Claims 5-6 and 9-10 [D.I. 69-21, PA 184]).</p> <p>"... wherein the corrosion inhibiting compound employed is from about 0.08 to about 0.2 molar equivalent." ('943 patent, Claims 7-8 [D.I. 69-21, PA 184]).</p> <p>Extrinsic evidence support:</p> <p>Corrosion inhibitor: A chemical that stops (or at least decreases the rate of) a corrosion process. The inhibitor can be added to an otherwise corrosive solution (often a very small concentration will</p>	

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	<p>accomplish the goal) or it can be incorporated in a coating applied to the metal surface. <i>Electrochemistry Dictionary and Encyclopedia</i>, available at http://web.archive.org/web/20001213064200/http://electrochem.cwru.edu/ed/dict.htm (Oct. 12, 2000). [D.I. 69-29, PA 247].</p> <p>Corrosion inhibitor: Any material used by the steel industry to inhibit corrosion. This includes the use of plastic coatings. <i>Rosato's Plastics Encyclopedia and Dictionary</i> (1993) [D.I. 69-30, PA 250].</p> <p>Corrosion inhibitor: Any material used by the steel industry to inhibit corrosion. This includes chemicals, oils, treated packaging materials, etc. <i>Compilation of American Society for Testing and Materials (ASTM) Standard Definitions</i> (5th ed. 1982) [D.I. 69-31, PA 252].</p> <p>Corrosion inhibitor: (physical chemistry) A compound or material deposited as a film on a metal surface that either provides physical protection against corrosive attack or reduces the open-circuit potential difference between local anodes and cathodes and increases the polarization of the former. <i>McGraw-Hill Dictionary of Scientific and Technical Terms</i> (6th ed. 2002) [D.I.</p>	

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	<p>69-24, PA 233].</p> <p>Inhibition: [Sci Tech] The act of repressing or restraining a physical or chemical action. <i>McGraw-Hill Dictionary of Scientific and Technical Terms</i> (5th ed. 1994) [D.I. 69-23, PA 229].</p> <p>Inhibitor: [Chem] A substance which is capable of stopping or retarding a chemical reaction. <i>McGraw-Hill Dictionary of Scientific and Technical Terms</i> (5th ed. 1994) [D.I. 69-23, PA 229-230]. <i>McGraw-Hill Dictionary of Chemistry</i>, (1997) [D.I. 69-25, PA 237].</p> <p>Inhibitor: Chemistry: a substance that decreases the rate of or stops completely a chemical reaction. <i>Random House Webster's Unabridged Dictionary</i> (2d ed. 1997) [D.I. 69-28, PA 246].</p> <p>Inhibit: Chemistry: to decrease the rate of action of or stop (a chemical reaction). <i>Random House Webster's Unabridged Dictionary</i> (2d ed. 1997) [D.I. 69-28, PA 246].</p> <p>Inhibit: to stop, prevent, or decrease the rate of (a chemical reaction). <i>Collins English Dictionary - Complete & Unabridged</i> (4th ed. 1998) [D.I. 69-27, PA 243].</p>	

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